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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,113	02/15/2002	Hitoshi Urabe	0879-0377P	8909
2292	7590	04/11/2007	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			MEYERS, MATTHEW S	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/11/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/076,113	URABE ET AL.	
	Examiner	Art Unit	
	Matthew S. Meyers	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12/18/2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's communication on 12/18/06, wherein claims 1-42 are currently pending.
- 2.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's has amended claims reciting, "a receiving device which receives image selection information indicating that the stored image is selected to be *retained stored*." Applicant's language makes no sense and is grammatically incorrect.

5. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner is unable to determine what the determining device is?

6. Claims 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner is unable to ascertain what is being accomplished by the recording device not duplicitely recording is accomplishing. What does applicant mean?

7. Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's claims purport to be an apparatus and a system respectively. However, applicant is reciting intended use within. For example, claim 1 recites inter alia, "a receiving device which receives image selection information indicating that the stored image is selected to be retained stored." Here, applicant has given the intended use of the receiving device which renders the claim indefinite. A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process. MPEP § 2173.05(p)(II).

8. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims a function, what is that?

9. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's claims contains two transitional sentences, the first an apparatus and the second, a method. A claim cannot be both a method and apparatus. It must be clear from the wording of the claim that it is drawn to one or the other of the mutually exclusive statutory classes of invention set forth in 35 U.S.C. 101.

The Board of Patent Appeals and Interferences, has made it clear that reciting both an apparatus and a method of using that apparatus renders a claim indefinite

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under section 112, paragraph 2. *Ex parte Lyell*, 17 USPQ2d 1548 (BPAI 1990). As the Board noted in *Lyell*, "the statutory class of invention is important in determining patentability and infringement." Id. at 1550 (citing *In re Kuehl*, 475 F.2d 658, 665 (CCPA 1973); *Rubber Co. v. Goodyear*, 76 U.S. 788, 796, 19 L. Ed. 566 (1870)). The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. Id. Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. Id. at 1550-51. This rule is well recognized and has been incorporated into the PTO's Manual of Patent Examination Procedure. § 2173.05(p)(II).

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 41 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. A method or process claim is an act or a series of acts and from

the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to an apparatus must distinguish in terms of structure.

For example, the preamble of claim 42 is directed towards a method, however, the first transitional sentence is directed towards an apparatus, and recites structure. Subsequently, the second transitional sentence directs the claim back to method steps. As a result it is unclear as to which recognized statutory class of invention the "image storing method" of claim 42 is directed towards.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson et al. (U.S. 6,760,128 B2)(Hereinafter referred to as Jackson).

3. With respect to **Claim 1**:

Jackson discloses an image storing apparatus, comprising:

an image capturing device which captures an image (Jackson col. 5, lines 64-66, "obtained from the digital camera");

an image storing device which stores the image captured by the image capturing device (Jackson col. 5, lines 1-2, "long-term storage");
a customer information storing device which stores customer information (Jackson col. 5, lines 26-40, "the user enters their name");
a receiving device which receives image selection information indicating that the stored image is selected to be retained stored (Jackson col. 6, lines 8-15, "the user can select additional images to be uploaded by clicking the mouse...");
and
an image management information storing device which stores image management information associating the image stored in the image storing device and indicated by the image selection information received by the receiving device with the customer information stored in the customer information storing device (Jackson col. 4, lines 26-41, "page captions, image captions").

4. With respect to **Claim 2:**

Jackson discloses the image storing apparatus according to claim 1, wherein:

the receiving device receives image attribute information; and the image management information storing device stores the image stored in the image storing device (Jackson col. 6, lines 34-38, "the image identifiers corresponding to each of the customer's uploaded images, and the designated date indicating the date the image was uploaded, are added to the user's service account information.").

5. With respect to **Claim 3:**

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Jackson discloses the image storing apparatus according to claim 1, wherein the image storing device and the image management information-storing device are the same database (Jackson col. 4, lines 21-23).

6. With respect to **Claim 4:**

Jackson discloses the image storing apparatus according to claim 1, further comprising:

an image storing period measuring device which measures a storing period of the image (Jackson col. 3, lines 9-16, "as the time between the current date and the designated date becomes larger."); and

a notifying device which, when the storing period measured by the image storing period measuring device passes a predetermined period, notifies the customer of the image so as to prompt input of one of the image selection information and image attribute information (Jackson col. 10, lines 56-58, "the user can be sent an email reminder...").

7. With respect to **Claim 6:**

Jackson discloses the image storing apparatus according to claim 1, further comprising:

a usage charge calculating device which calculates a usage charge according to a using area and a storing period of the image stored in the image storing device; and a usage charge notifying device which notifies the customer of the usage charge calculated by the usage charge calculating device (Jackson

col. 9, 62-67, col. 10, lines 1-50 and col. 13, lines 66-67, col. 14, line 1, "pay a monthly fee for storage.").

8. With respect to **Claim 9:**

Jackson discloses the image storing apparatus according to claim 1, further comprising: a receiving device which receives customer reading authorization information indicating that the customer has authorized the customer information to be read; and a sending device which reads the customer information corresponding to the customer reading authorization information received by the receiving device from the customer information storing device and sends the read customer information to another customer (Jackson col.5, lines 26-40, "This information identifies the user and one or more designees.").

9. With respect to **Claim 10:**

Jackson discloses the image storing apparatus according to claim 1, further comprising: a receiving device which receives image usage authorization information authorizing usage of the image (Jackson col. 5, lines 58-60, "customer selects images to be uploaded...").

10. With respect to **Claim 11:**

Jackson discloses the image storing apparatus according to claim 1, further comprising:

a classified information storing device which stores classified information having classified the images stored in the image storing device according to at least one of the customer information and the image attribute information

(Jackson col. 6, lines 34-38 "image identifiers corresponding to each of the customer's uploaded images..."); and

a receiving device which receives classified reading authorization information authorizing the images belonging to a predetermined classification to be read (Jackson col. 6, lines 25-26),

wherein at least one of the image storing device and the classified information storing device authorizes a third party to access the image belonging to the classification indicated by the classified reading authorization information received by the receiving device and prohibits the third party from accessing any image belonging to any classification other than the one indicated by the received classified reading authorization information (Jackson col. 1, lines 46-62, "...the user can select particular images for printing or sharing with third parties designated by the user.").

11. With respect to **Claim 12:**

Jackson discloses the image storing apparatus according to claim 1, further comprising:

a date timing device which times the current date (Jackson col. 6, lines 34-37, "...the designated date indicating the date the image was uploaded...");

an event analyzing device which analyzes an event related to the customer based on at least one of the customer information and the image attribute information stored in the image management information storing device (Jackson col. 10, lines 56-57); and

an event notifying device which, when the current date timed by the date timing device is within a predetermined period before the date of the event analyzed by the event analyzing device, gives notice of the event analyzed by the event analyzing device (Jackson col. 10, lines 56-57).

12. With respect to **Claim 13:**

Jackson discloses the image storing apparatus according to claim 1, further comprising: a receiving device which receives image output destination information identifying the image, an output location of the image and a record medium for the image; a sending device which reads the image identified by the image output destination information from the image storing device based on the image output destination information received by the receiving device, and sends the read image to a record medium recording apparatus placed in an output location identified by the image output destination information and recording data on the record medium indicated by the image output destination information (Jackson col. 4, lines 54-61, "The production controller controls one or more color hardcopy printers...is also connected to a CD writer...").

13. With respect to **Claim 14:**

Jackson discloses an image storing system, comprising:

a plurality of terminal units (Jackson col. 8, line 21, "the home computer system"), each of which comprises:

an image selecting device which selects the image to be stored (Jackson col. 6, lines 8-15, "the user can select additional images to be uploaded by clicking the mouse..."); and

a sending device which sends the image selected by the image selecting device and image selection information indicating the image (Jackson col. 4, lines 14-17, "The fulfillment center is connected to the channel, such as the internet, by a network server, such as an internet server..."); and

an image storing apparatus comprising (Jackson col. 5, lines 1-2, "long-term storage"):

an image capturing device which captures the image (Jackson col. 5, lines 64-66, "obtained from the digital camera");

an image storing device (Jackson col. 5, lines 1-2, "long-term storage");

a customer information storing device which stores customer information (Jackson col. 5, lines 26-40, "the user enters their name");

a receiving device which receives image selection information sent from the terminal unit indicating that the stored image is selected to be retained; (Jackson col. 8, lines 18-22, "the network server transfers image designators for the images uploaded earlier by the user..."); and

an image management information storing device which stores image management information associating the image stored in the image storing device and indicated by image selection information received by the receiving device with the customer information stored in the customer information storing

device (Jackson col. 8, lines 58-67, "The image list in the service account information provides a list of image identifiers...").

14. With respect to **Claim 15**:

Jackson discloses the image storing system according to claim 14, wherein:

the sending device of the terminal unit sends image attribute information indicating an attribute of the image as one piece of the image selection information (Jackson col. 5, lines 45-47, "image identifier");

the receiving device of the image storing apparatus receives the image attribute information from the terminal unit as one piece of the image selection information (Jackson col. 6, lines 34-38, "the image identifiers corresponding to each of the customer's uploaded images, and the designated date indicating the date the image was uploaded, are added to the user's service account information."); and

the image management information storing device of the image storing apparatus stores the image stored in the image storing device and indicated by the image attribute information received by the receiving device by associating the image with the image attribute information and the customer information stored in the customer information storing device (Jackson col. 8, lines 58-67, "The image list in the service account information provides a list of image identifiers...").

15. With respect to **Claim 16**:

Jackson discloses the image storing system according to claim 14, wherein the image storing apparatus further comprises:

an image storing period measuring device which measures a storing period of the image; and a notifying device which, when the storing period measured by the image storing period measuring device passes a predetermined period, notifying the customer of the image so as to prompt input of at least one of the image selection information and image attribute information (Jackson col. 10, lines 56-58, "the user can be sent an email reminder...").

16. With respect to **Claim 18:**

Jackson discloses the image storing system according to claim 14, wherein the image storing apparatus further comprises:

a calculating device which calculates a usage charge according to a storing area and a storing period of the image stored in the image storing device; and a notifying device which notifies the customer of the usage charge calculated by the calculating device (Jackson col. 9, 62-67, col. 10, lines 1-50 and col. 13, lines 66-67, col. 14, line 1, "pay a monthly fee for storage.").

17. With respect to **Claim 21:**

Jackson discloses the image storing system according to claim 14, wherein: the terminal unit further comprises:

an input device which inputs customer reading authorization information indicating that the customer has authorized the customer information to be read (Jackson col.5, lines 26-40, "The user enter his name..."); and

a sending device which sends the customer reading authorization information inputted by the input device; and the image storing apparatus further comprises: a receiving device which receives the customer reading authorization information sent from the terminal unit; and a sending device which reads customer information indicated by the customer reading authorization information received by the receiving device and sends the read customer information to another customer (Jackson col.5, lines 14-25, "using a digital communication network").

18. With respect to **Claim 22:**

Jackson discloses the image storing system according to claim 14, wherein: the terminal unit further comprises:

an input device which inputs image usage authorization information indicating usage authorization of the image (Jackson col.5, lines 26-40, "The user enter his name..."); and

a sending device which sends the image usage authorization information inputted by the input device; and the image storing apparatus further comprises a receiving device which receives the image usage authorization information sent from the terminal unit (Jackson col.5, lines 14-25, "using a digital communication network"); and

at least one of the image storing device and the image management information storing device authorizes a third party to access the image indicated by the image usage authorization information received by the receiving device

and prohibits the third party from accessing any image other than the image indicated by the image usage authorization information (Jackson col.5, lines 26-40, "This information identifies the user and one or more designees.").

19. With respect to **Claim 23:**

20. Jackson discloses the image storing system according to claim 14, wherein: the image storing apparatus further comprises:

a classified information storing device which stores classified information having classified the images stored in the image storing device according to at least one of the customer information and the image attribute information (Jackson col. 6, lines 34-38 "image identifiers corresponding to each of the customer's uploaded images..."); and

a receiving device which receives classified reading authorization information authorizing the images belonging to a predetermined classification to be read (Jackson col. 6, lines 25-26); and

at least one of the image storing device and the classified information storing device authorizes a third party to access the image belonging to the classification indicated by the classified reading authorization information received by the receiving device and prohibits the third party from accessing any image belonging to any classification other than the one indicated by the received classified reading authorization information (Jackson col. 1, lines 46-62, "...the user can select particular images for printing or sharing with third parties designated by the user.").

21. With respect to **Claim 24:**

Jackson discloses the image storing system according to claim 14, wherein: the image storing apparatus further comprises:

a date timing device which times the current date (Jackson col. 6, lines 34-37, "...the designated date indicating the date the image was uploaded...");
an event analyzing device which analyzes an event related to the customer based on at least one of the customer information and the image attribute information stored in the image management information storing device (Jackson col. 10, lines 56-57); and
an event notifying device which, when the current date timed by the date timing device is within a predetermined period before the date of the event analyzed by the event analyzing device, gives notice of the event analyzed by the event analyzing device (Jackson col. 10, lines 56-57).

22. With respect to **Claim 25:**

Jackson discloses the image storing system according to claim 14, wherein: the terminal unit further comprises:

an input device which inputs image output destination information identifying the image, an output location of the image and a record medium for the image (Jackson col. 4, lines 54-61, "The production controller controls one or more color hardcopy printers...is also connected to a CD writer..."); and
a sending device which sends the image output destination information inputted by the input device; and the image storing apparatus further comprises:

a receiving device which receives the image output destination information sent from the terminal unit (Jackson col.5, lines 14-25, "using a digital communication network"); and

an image sending device which reads the image identified by the image output destination information from the image storing device based on the image output destination information received by the receiving device and sends the read image to a record medium recording apparatus placed in an output location identified by the image output destination information and recording data on the record medium indicated by the image output destination information (Jackson col. 4, lines 54-61, "The production controller controls one or more color hardcopy printers...is also connected to a CD writer...").

23. With respect to **Claim 27:**

Jackson discloses a terminal unit, comprising:

an image selecting device which selects an image to be stored (Jackson col. 6, lines 8-15, "the user can select additional images to be uploaded by clicking the mouse..."); and

a sending device which sends the image selected by the image selecting device and image selection information indicating that the stored image is selected to be retained stored (Jackson col. 4, lines 14-17, "The fulfillment center is connected to the channel, such as the internet, by a network server, such as an internet server...").

24. With respect to **Claim 28:**

Jackson discloses the terminal unit according to claim 27, wherein the sending device sends image attribute information indicating an attribute of the image as one piece of the image selection information (Jackson col. 5, lines 45-47, "image identifier").

25. With respect to **Claim 29:**

Jackson discloses the terminal unit according to claim 27, further comprising:

an input device which inputs customer reading authorization information indicating that the customer has authorized the customer information to be read (Jackson col.5, lines 26-40, "The user enter his name..."); and

a sending device which sends the customer reading authorization information inputted by the input device (Jackson col.5, lines 14-25, "using a digital communication network").

26. With respect to **Claim 30:**

Jackson discloses the terminal unit according to claim 27, further comprising:

an input device which inputs image usage authorization information indicating usage authorization of the image (Jackson col.5, lines 26-40, "The user enter his name..."); and

a sending device which sends the image usage authorization information inputted by the input device (Jackson col.5, lines 14-25, "using a digital communication network").

27. With respect to **Claim 31:**

Jackson discloses the terminal unit according to claim 27, further comprising:

an input device which inputs output destination information identifying the image, an output location of the image and a record medium for the image (Jackson col. 4, lines 54-61, "The production controller controls one or more color hardcopy printers...is also connected to a CD writer..."); and

a sending device which sends the image output destination information inputted by the input device (Jackson col.5, lines 14-25, "using a digital communication network").

28. With respect to **Claim 33:**

Jackson discloses an image storing apparatus having a recording device which records an image uploaded from a customer side, the apparatus comprising:

a receiving device which receives the image from a communication apparatus on the customer side (Jackson col. 5, lines 58-60, "the customer selects images to be uploaded from the home computer");

a recording device which records the received image (Jackson col. 5, line 59, "in order to be stored by the service provider");

a determining device which determines whether or not to move the image recorded on the recording device to a record medium by comparing at least one of the capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding at least one of predetermined thresholds (Jackson col. 3, lines 45-67, "CPU"); and

a moving device which moves the image recorded on the recording device to the record medium based on results of the determination (Jackson col. 3, lines 45-67, "CPU").

29. With respect to **Claim 34:**

Jackson discloses the image storing apparatus according to claim 33, wherein:

the receiving device receives from a customer-side communication apparatus image movement acknowledgement information for acknowledging the images to be moved from the recording device to the record medium (Jackson col. 8, lines 42-46, "the user selects the images to be used to produce the photo products they have selected"; and

the moving device moves the image recorded on the recording device to the record medium based on the image movement acknowledgement information received from the customer-side communication apparatus and the determination results (Jackson col. 4, lines 59-61, "...which can produce PictureCDs...").

30. With respect to **Claim 35:**

Jackson discloses the image storing apparatus according to claim 33, wherein:

the receiving device receives from the customer-side communication apparatus payment information for paying a purchase price of the record medium having recorded the moved image (Jackson col. 4, lines 43-54, "the customer's account is debited"); and

the moving device moves the image recorded on the recording device to the record medium based on the payment information received from the

customer-side communication apparatus and the determination results (Jackson col. 4, lines 43-54, "the electronic database communicates with the billing system to verify the payment identifier is valid...").

31. With respect to **Claim 36:**

Jackson discloses the image storing apparatus according to claim 33, wherein:

the receiving device receives from the customer-side communication apparatus record medium type information for identifying the type of the record medium (Jackson col. 4, lines 43-54); and

the moving device moves the image recorded on the recording device to the identified record medium based on the record medium type information received from the customer-side communication apparatus (Jackson col. 4, lines 43-54).

32. With respect to **Claim 37:**

Jackson discloses the image storing apparatus according to claim 33, further comprising a printing device which prints at least one of a name of the image and a reduced image recorded on the record medium on at least one of a list and a label to be affixed to the record medium (Jackson col. 4, lines 54-61, "The production controller controls one or more color hardcopy printers...is also connected to a CD writer...").

33. With respect to **Claim 38:**

Jackson discloses the image storing apparatus according to claim 33, further comprising a delivery device which delivers the record medium to the customer side

(Jackson col. 11, lines 53-65, "The term delivery means the product can be shipped to the customer").

34. With respect to **Claim 39:**

Jackson discloses the image storing apparatus according to claim 33, wherein the recording device does not duplicitely record the same image as that already recorded on the recording device (Jackson col. 11, lines 12-14, "the production controller produces customized photo products using the uploaded images...").

35. With respect to **Claim 40:**

Jackson discloses the image storing apparatus according to claim 33, wherein the moving device does not duplicitely move the same image as that already moved to the record medium (Jackson col. 11, lines 12-14, "the production controller produces customized photo products using the uploaded images...").

36. With respect to **Claim 41:**

Jackson discloses an image storing program which runs on an image storing apparatus having a recording device which records an image uploaded from a customer side, wherein: the image storing apparatus comprises:

a receiving device which receives the image (Jackson col. 2, line 8, "receiving");

a recording device which records the image (Jackson col. 2 line 8, "storing," Jackson col. 4, lines 59-61, "...which can produce PictureCDs...," Jackson col. 4, line 56, "hardcopy printers");

a determining device which determines whether or not to move the image recorded on the recording device to a record medium by comparing information of the image recorded on the recording device to a predetermined threshold; a moving device which moves the image recorded on the recording device to the record medium based on results of the determination ; and an information processing device which controls the receiving device, the recording device, the determining device and the moving device; and the program implements to the information processing device: a function in which the receiving device receives the image from a customer-side communication apparatus (Jackson col. 3, lines 45-67, "CPU");

a function in which the recording device records the received image (Jackson col. 2 line 8, "storing," Jackson col. 4, lines 59-61, "...which can produce PictureCDs...," Jackson col. 4, line 56, "hardcopy printers");

a function in which the determining device determines whether or not to move the image recorded on the recording device to the record medium by comparing at least one of capacity, quantity, a recording period and a current date thereof recorded on the recording device to corresponding at least one of predetermined thresholds (Jackson col. 6, lines 34-38, "the image identifiers"); and

a function in which the moving device moves the image recorded on the recording device to the record medium based on results of the determination (Jackson col. 3, lines 45-67, "CPU").

37. With respect to **Claim 42:**

Jackson discloses an image storing method in an image storing apparatus having a recording device which records an image uploaded from a customer side, wherein: the image storing apparatus comprises:

- a receiving device which receives the image (Jackson col. 2, line 8, "receiving");
 - a recording device which records the image (Jackson col. 2 line 8, "storing," Jackson col. 4, lines 59-61, "...which can produce PictureCDs...," Jackson col. 4, line 56, "hardcopy printers");
 - a determining device which determines whether or not to move the image to a record medium by comparing information of the image recorded on the recording device to a predetermined threshold (Jackson col. 3, lines 45-67, "CPU"); and
 - a moving device which moves the image to the record medium based on results of the determination (Jackson col. 3, lines 45-67, "CPU"); and
- the method comprises: a step in which the receiving device receives the image from a customer-side communication apparatus (Jackson col. 5, lines 58-60, "the customer selects images to be uploaded from the home computer");
- a step in which the recording device records the received image (Jackson col. 2 line 8, "storing," Jackson col. 4, lines 59-61, "...which can produce PictureCDs...," Jackson col. 4, line 56, "hardcopy printers");

a step in which the determining device determines whether or not to move the image recorded on the recording device to the record medium by comparing at least one of capacity, quantity, recording period and a current date thereof recorded on the recording device to corresponding one of predetermined thresholds; and a step in which the moving device moves the image recorded on the recording device to the record medium based on results of the determination (Jackson col. 6, lines 34-38, "the image identifiers").

Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

40. Claims 7-8 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42 above.

41. With respect to **Claims 7-8 and 19-20:**

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42. **Claims 7 and 19** are rejected under 35 U.S.C. 103 as being unpatentable over Jackson. Jackson discloses a payment schedule which allows a customer to "pay a monthly fee for storage" (Jackson col. 14, lines 6-10). Jackson does not explicitly disclose prohibiting the customer in arrears from getting access where a charge is not paid within a predetermined period after the notice of the usage charge are given by the usage charge-notifying device. However, collection service is a key factor in the success of any business, whether it be brick and mortar or online. Terminating service to a customer who is in arrears is the most common vehicle for businesses to ensure their timely collections. Businesses have resorted to many different techniques of collections but no technique is as successful as a termination of service to get a customer current with his/her bill. This practice is well known in the business community and would follow in the internet world as well where competition is sometimes worldwide and collections would be a much more daunting task. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to terminate service to a customer in arrears while using the payment schedule for utilizing stored images in Jackson.

43. With respect to **Claim 20:**

Jackson discloses the image storing system according to claim 19, wherein the image storing apparatus further comprises: a point calculating device which calculates points according to a storing area and a storing period of the image stored in the image storing device; and a point storing device which accumulatively stores the points calculated by the point calculating device for each customer (Jackson col. 13, lines 66-

67, col. 14, line 1, "pay a monthly fee for storage," Jackson col. 10, lines 20-22, "The multiplier increases as the difference between the order data and the designated date increases...") (Examiner notes that a point calculating device is merely a payment scheme synonymous to a credit card payment system. Moreover, at no point in the spec is reference made to a value represented by the points or a method of how the points are accumulated.).

44. With respect to **Claims 8 and 20:**

Jackson discloses a point calculating device which calculates points according to a storing area and a storing period of the image stored in the image storing device; and a point storing device which accumulatively stores the points calculated by the point calculating device for each customer (Jackson col. 13, lines 66-67, col. 14, line 1, "pay a monthly fee for storage," Jackson col. 10, lines 20-22, "The multiplier increases as the difference between the order data and the designated date increases...") (Examiner notes that a point calculating device is merely a payment scheme synonymous to a credit card payment system. Moreover, at no point in the spec is reference made to a value represented by the points or a method of how the points are accumulated.).

45. **Claims 5 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42 above, and further in view of Manolis et al. (U.S. 6,583,799 B1) (Hereinafter referred to as Manolis).

46. With respect to **Claims 5 and 17:**

Jackson discloses the image storing apparatus. However, Jackson fails to disclose when the receiving device receives none of the image selection information

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and the image attribute information within the predetermined period from the notification, the image storing device deletes the image which is a subject of the notification. Manolis explicitly discloses a system, which notifies the user with an error message in the event that the upload was unsuccessful. The notification can be sent by email and inform the user on how to restart the upload. If the unload is unsuccessful the system informs the users to start the process over, deleting the incomplete file and beginning the upload process from the beginning (Manolis col. 8, lines 7-43).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the payment schedule for utilizing stored images in Jackson with the image upload method in Manolis in order to minimize incomplete files and provide an automatic notification system to inform its user of a possible error. This capability would ensure foolproof operation and increase customer satisfaction while at the same time minimizing any superfluous files, which would only act to clog the server.

47. **Claims 26 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claims 1-4, 6, 9-16, 18, 21-25, 27-31 and 33-42 above, and further in view of Cook et al. (U.S. 6,786,655 B2) (Hereinafter referred to as Cook).

Jackson discloses the image storing system according to claim 14, wherein: the terminal unit further comprises:

a printing device which prints the image image-processed by the image processing device (Jackson col. 4, line 56, "hardcopy printers"); and

the image sending device sends the image image-processed by the image processing device to the image storing apparatus (Jackson col.5, lines 14-25, "using a digital communication network")

Jackson does not explicitly disclose an image reading device, which reads the image, recorded on a film or an image processing device which performs predetermined image processing to the image read by the image reading device. However, Cook teaches an image reading device, which reads the image, recorded on a film (Cook col. 3, lines 63-64, "The film processing system operates to receive a roll of film from a customer."). Additionally, Cook teaches an image processing device which performs predetermined image processing to the image read by the image reading device (Cook col. 4, lines 1-3, "The film processing system develops and digitizes the film...").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the payment schedule for utilizing stored images in Jackson with the system for self-service film processing in Cook. This combination would help accommodate consumers who still wish to use traditional silver-halide film in lieu of newer digital technology. By accommodating both the new and traditional film mediums, a provider would be able to increase its costumer base and enable traditional film user to enjoy all the benefits the newer technology has effectuated.

Response to Arguments

48. With respect applicant's argument, Examiner respectfully disagrees. Applicant has directed his claim to an apparatus and therefore, the intended use is given little patentable as long as the prior art structure is fully capable of performing that function. The examiner assert that the CPU in Jackson is fully capable of performing that function.

49. As for duplicating, the Examiner gives the broadest interpretation under MPEP 2114. Therefore, Examiner asserts that it meets the claim limitation.

50. As for the newly amended claim language, The Examiner asserts that the prior meets the claimed limitations. The applicant is directed to Examiner's 112 2nd paragraph rejection addressing this.

51. As to applicant's arguments regarding official notice, a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain

adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971). If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art.

52. With respect to claim 39, given the broadest reasonable interpretation, the Examiner asserts that Jackson discloses, not duplicitely recording the same image when recording the image. Examiner refers applicant to 112 2nd paragraph rejection addressing this.

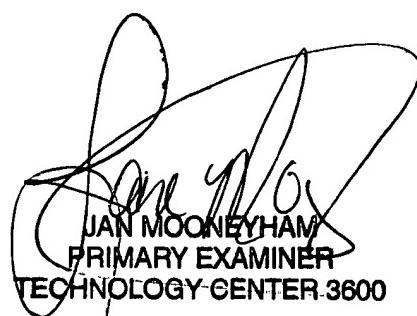
53. It appears to the Examiner that applicant is trying to claim a system by what it does rather than by its structure. Independent claim 1 is to an apparatus, 14, to a system, 27, an apparatus, 33, an apparatus, and claims 41 and 42 are hybrid claims which Examiner is unable to determine what class they fall into. Examiner notes that the intended use of the structure in any apparatus/system claim is given little patentable weight as long as the structure in the prior art is capable of performing that function. As noted above, in the 112's applicant uses terms like, "a function in which," which is unclear to the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Meyers whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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